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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,426	01/07/2005	Toshiaki Yamaguchi	Q85464	5918
23373	7590	03/16/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHU, YONG LIANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/520,426

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Yong Chu

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7 January 2005</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

Claims 1-5 are pending in the instant application.

***Information Disclosure Statement***

Applicant's Information Disclosure Statements, filed on 7 January 2005, have been considered. Please refer to Applicant's copies of the PTO-1449 submitted herewith.

***Priority***

This application is a 371 of PCT/JP03/08085, filed on 26 June 2003. Acknowledgement is made of Applicant's claim for Japan Patent Application 2002-199311, filed on 8 July 2002.

***Response to Restriction***

The response to the Lack of Unity request with election of Group I (e.g. claims 1-3) *without traverse* by Applicants' representative, Peter D. Olexy dated on 23 February 2006, has been considered.

Claims 1-3 are currently examined first. If some of the claims are potential allowable, the rest claims will be examined.

**Claim Rejections - 35 USC § 102(b)**

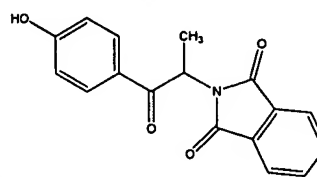
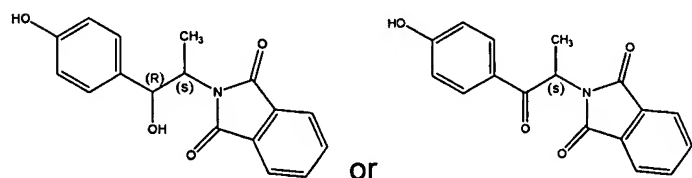
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102 (b) as being anticipated by Mueller et al., *Archiv der Pharmazie und Berichte der Deutschen Pharmazeutischen Gesellschaft* (1968), 301(2), 161-7 (See attached STN search report).

Applicants instant elected invention in claims 1-3 teaches compounds of formulas



Mueller et al. teach a specific compound in *Archiv der Pharmazie und Berichte der Deutschen Pharmazeutischen Gesellschaft* (1968), 301(2), 161-7, which is the same ketone compound as defined in claim 1 and 2. However, claim 3 is potential allowable.

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Because this is a PCT 371 National Stage Application, and claim 3 is potential allowable, the rest of claims (e.g. 4 and 5) under PCT Rule 13 Annex B, Part 1 (e) are also examined.

### ***Claim Rejections - 35 USC § 112***

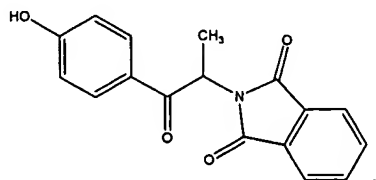
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-5, the phrase "derivative" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "derivative"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: description of catalytic hydrogenating a

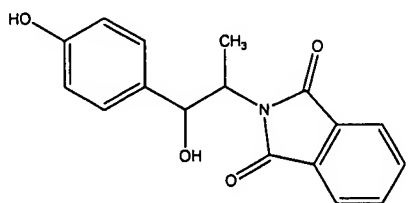


phenol compound

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Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: description of removing the phthaloyl group of

the phenol compound



### ***Conclusion***

No claims are allowed.

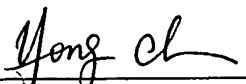
### ***Telephone Inquiry***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
\_\_\_\_\_  
Yong Chu, Ph.D.  
Patent Examiner  
Art Unit 1626

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER  
  
\_\_\_\_\_  
for Joseph M. McKane  
Supervisory Patent Examiner  
Art Unit 1626